



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Guoqiang Wang, *et al*

EXAMINER: R. Anderson

SERIAL NO.: 10/007,342

GROUP ART UNIT: 1626

FILED: October 22, 2001

ATTY. DOCKET NO.: ENP-035

TITLE: Nitrogen Heterocycle Inhibitors of Aspartyl Protease

1626
RECEIVED
NOV 06 2002
TECH CENTER 1600/2300
F. TUCK
#4
11/9/02

**RESPONSE TO REQUIREMENT FOR RESTRICTION AND
REQUIREMENT FOR ELECTION OF SPECIES**

Box Non-Fee Amendment

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Sir:

This paper is in response to the Office Action mailed September 30, 2002 in the above-identified application for Letters Patent.

1. The examiner has made a requirement for restriction between two groups of claims as follows:

I. Claims 1-16 and 21-22, drawn to products of the formula as found in claim 1, variously classified.

II. Claims 17-22 drawn to methods of treating protease-precipitated diseases with products of the formula as found in claim 1, variously classified.

It is noted that the claims of Group II, identified as being drawn to methods of treating protease-precipitated diseases, have been shown as 17-22. The examiner obviously meant to specify claims 17-20.

In support of the requirement for restriction the examiner has asserted that the respective groups of claims are related as product and process of use and that the product as claimed can be used in a materially different process of using that product,

i.e., the treatment of HIV or Breast Cancer. It has also been asserted that not to require restriction would result in a burden being imposed on the search and examination of the application.

Applicants request reconsideration of the requirement for restriction. The two sets of claims, as grouped by the examiner, recite subject matter which is so closely related as to warrant examination of all the claims in the application.

Restriction between claims of different statutory categories present in one application is not mandatory but rather is within the discretion of the United States Patent and Trademark Office ("USPTO"). The statutory authority for restriction practice, 35 USC §121, states that restriction between two or more independent and distinct inventions claimed in one application may (emphasis added) be required and further provides that the validity of a patent may not be questioned for failure to require the application to be restricted to one invention.

Here, all the claims in the application could be examined conveniently in one application since the compounds and compositions recited in the Group I claims are recited in the Group II claims in the context of a method of treating or preventing a protease-precipitated disease, which is the utility taught in the application for the compounds and compositions. Thus, the subject matter of the respective groups of claims is so closely related that the sound exercise of discretion dictates the examination of all the claims in the present application.

Nevertheless, should the USPTO continue to assert the restriction requirement, applicants provisionally select the claims of Group I (1-16, 21 and 22) for examination without prejudice to their right, pursuant to 35 USC §121, to file a divisional application to the non-elected claims (17-20).

2. The examiner has also required applicants to elect a single disclosed species for examination.

In compliance with this requirement, applicants hereby elect compound EP 001162 (see Table 1, page 22). The claims readable on this single elected species are 1, 2, 4-12, 14-16, 21 and 22.

It is noted that the examiner has also stated

"Upon election of a single disclosed species, a generic concept inclusive of the elected species will be identified by

the Examiner for examination along with
the elected species.”

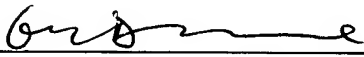
It is not understood what is meant by this statement. There is no provision in the statute or the rules of practice which allow for the identification of a generic “concept” for examination. It is fundamental that the claims presented by applicants must be examined. It is improper for the USPTO to refuse to examine the subject matter which applicants regard as their invention unless the subject matter in a claim lacks unity of invention. See M.P.E.P. Section 803.02. Here, no allegation has been made that any claim in the application lacks unity of invention.

In accordance with current USPTO species practice, the claims which are readable upon the elected species must be examined. Further, upon allowance of a claim or claims which are generic to the elected species, 37 CFR §1.141 provides that a reasonable number of species may be claimed in one application. Thus, claims 1, 2, 4-12, 14-16, 21 and 22, which are readable upon the elected species, must be examined in the present application.

In summary, reconsideration of the requirement for restriction, withdrawal thereof from the application and examination of all the claims in the application are respectfully requested.

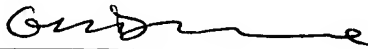
Alternately, examination of claims 1, 2, 4-12, 14-16, 21 and 22 is requested.

Respectfully submitted,

By: 
Gaetano D. Maccarone
Reg. No. 25,173

Certificate of Mailing under 37 C.F.R. § 1.8(a)

I hereby certify that this correspondence is being deposited today with the United States Postal Service as First Class Mail in an envelope addressed to: Box Non-Fee Amendment, Commissioner for Patents, Washington, D.C. 20231.


Gaetano D. Maccarone
Reg. No. 25,173
Date: 10/29/2002